

### **REMARKS/ARGUMENTS**

Claims 1 and 4-20 are pending and stand rejected in the above-captioned application.

#### **I. Status of the Claims**

Applicants gratefully acknowledge the Examiner's withdrawal of the rejections from the previous Office Action.

#### **II. Claim Rejections under 35 U.S.C. §102**

Claims 1, 4 and 19 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,486,335 ("Wilding"). Applicants respectfully assert that this rejection is inapplicable to the newly amended version of claim 1. Support for the amendments to claim 1 can be found, e.g., from page 19 line 7 – page 20 line 9 of the application. Since claim 1 is not anticipated by Wilding, then the narrower claims dependent from claim 1 cannot be anticipated by Wilding.

Amended claim 1 covers a system comprising "a source of polarized excitation light, an optical train that directs the polarized excitation light toward the first microfluidic channel and that collects fluorescence emitted from the first microfluidic channel, means for separating the collected fluorescence into a component parallel to the excitation light and a component perpendicular to the excitation light, and means for separately detecting the parallel and perpendicular components". None of these claim elements appear to be disclosed in Wilding. To anticipate a claim under 35 U.S.C. 102(a), (b), or (e), a prior art reference must teach every element of the claim. MPEP 2131. Since Wilding does not appear to teach a system comprising the newly added elements of claim 1, Wilding cannot anticipate newly amended claim 1. So claims 1, 4, and 19 should be allowable over Wilding.

Claims 1 and 4 were also rejected under 35 U.S.C. §102(a) and (e) as allegedly being anticipated by U.S. Patent No. 5,942,443 ("Parce"). Newly amended claim 1 is allowable over Parce for the same reasons newly amended claim 1 is allowable over Wilding. Specifically, neither Parce nor Wilding appears to disclose all of the claim elements in newly amended claim 1. Since Parce does not anticipate claim 1, then Parce cannot anticipate the narrower dependent claim 4.

Claims 1, 4 and 19 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,074,827 ("Nelson"). Applicants again respectfully assert that this rejection is inapplicable to the newly amended version of claim 1. The same analysis presented for the Wilding and Parce references also applies to Nelson. Just as for Wilding and Parce, if Nelson does not anticipate claim 1, then Nelson cannot anticipate narrower dependent claims 4 and 19.

### III. Rejections Under 35 U.S.C. §103

Claims 5-18 and 20 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Nelson. This rejection appears to be based on the premise that claim 1 is anticipated by Nelson, and that the additional limitations in claims 5-18 and 20 are rendered obvious by the teaching of Nelson. Since Applicants assert that Nelson does not anticipate amended claim 1, the reasoning behind the obviousness rejection of claims 5-18 and 20 no longer applies. Accordingly, Applicant's assert that in light of the amendments to claim 1, claims 5-18 and 20 cannot be rendered obvious by Nelson.

Claims 5- 20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Parce. As was the case for the obviousness rejection based on Nelson, the obviousness rejection based on Parce appears to be based on the premise that Parce anticipates claim 1, and that the additional limitations in claims 5- 20 are rendered obvious by the teaching of Parce. Since Applicants assert that Parce does not anticipate amended claim 1, the reasoning behind the obviousness rejection based on Parce no longer applies. Accordingly, Applicant's assert that in light of the amendments to claim 1, claims 5-20 cannot be rendered obvious by Parce.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe that the present application is in condition for allowance and action toward that end is respectfully requested. If the Examiner believes that a telephone interview would expedite the examination of this application, the Examiner is requested to contact the undersigned at the telephone number below.

Respectfully submitted,



Donald R. McKenna  
Reg. No. 44,922

CALIPER LIFE SCIENCES, INC.  
605 Fairchild Drive  
Mountain View, CA 94043-2234  
Tel: 650-623-0737  
Fax: 650-623-0504  
[donald.mckenna@caliperls.com](mailto:donald.mckenna@caliperls.com)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 14, 2004, by Michael Moores.

Signed: \_\_\_\_\_

